

Remarks

Claims 1-16 are now in the case. Claim 1 has been amended to better describe that embodiment of the invention. Support for the amendment may be found in paragraph [0006]. The Examiner rejected claims 1-16 under 35 U.S.C. §103(a) as being unpatentable over Barry, GB622970. The Examiner stated that the Barry process differs from the instantly claimed process in that Barry "teaches a process that employs an aromatic hydrocarbon (benzene) as coupling solvent while the presently claimed invention employs toluene." Applicants would like to respectfully point out that the present process actually uses an aromatic halogenated coupling solvent such as chlorobenzene. This is a significant difference since the halogenated solvent acts not only as a solvent but also a reactant. It would not be obvious to one skilled in the art to substitute chlorobenzene or other halogenated aromatic solvents for benzene.

The Examiner also provisionally rejected claims 1-16 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of copending application no 10/585,154. The Examiner stated that "the claims differ in that the process of preparing diphenylchlorosilanes by the Grignard process comprising contacting a Grignard reagent, an ether solvent, a trichlorosilane and an aromatic hydrocarbon coupling solvent of the presently claimed invention employ chlorobenzene as an aromatic coupling solvent while the copending application no. 10/585,155 employ toluene as an aromatic coupling solvent." The Examiner further states that the differences "are not a patentable distinction because Application No. 10/585,154 teaches the elements of the claimed invention with sufficient guidance, particularity, and with a reasonable expectation of success, that the invention would be prima facie obvious to one of ordinary skill in the art. Although Applicants respectfully disagree with the Examiner, to further prosecution Applicants will submit a terminal disclaimer upon allowance of the case.

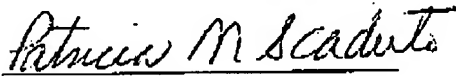
This reply is being submitted within the period for response to the outstanding office action. Although the Applicants believe in good faith that no extensions of time are needed, the Applicants hereby petition for any necessary extensions of time. You are authorized to charge

Page 5 of 6

deposit account 04-1520 for any fees necessary to maintain the pendency of this application.
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Respectfully Submitted,

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